

REMARKS

In the Office Action¹, the Examiner objected to claims 38 and 52 for informalities, rejected claims 38-44 under 35 U.S.C. § 101, as being directed to non-statutory subject matter, and rejected claims 31-54 under 35 U.S.C. § 103(a), as being unpatentable over Goerke et al., Employee Stock Plans Interface 1.0 Recommendation, October 2002 (“Goerke”) in view of U.S. Patent No. 6,980,963 to Hanzek (“Hanzek”).

By this Amendment, Applicants amend claims 31, 38, 45, and 52 to maintain proper antecedent bases and to correct minor matters of form. Claims 31-54 remain pending in this application.

A. Objection to Claims 38 and 52

Applicants have amended claims 38 and 52 to address the informalities noted by the Examiner. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the objection to claims 38 and 52.

B. Rejection of Claims 38-44 under 35 U.S.C. § 101

Applicants respectfully traverse the rejection of claims 38-44 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. The Examiner states, “[w]ith respect to claim 38, the computer-readable medium . . . is not limited to appropriate media in accordance with Applicant’s specification . . . , which states that information carrier may include a propagated signal.” Office Action, p. 3. Although Applicants

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

disagree, to advance prosecution, Applicants have amended the specification. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 38-44 under 35 U.S.C. § 101.

C. Rejection of Claims 31-54 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 31-54 under 35 U.S.C. § 103(a), as being unpatentable over Goerke in view of Hanzek, because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. See M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006). Moreover, "in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed." USPTO Memorandum from Margaret A. Focarino, Deputy Commissioner for Patent Operations, May 3, 2007, page 2.

A *prima facie* case of obviousness has not been established because, among other things, Goerke and Hanzek, taken alone or in any proper combination, fail to teach or suggest each and every element of Applicants' claims.

Independent claim 31 calls for a combination of features including, for example, "extracting, at a predetermined time, valid content data from the updated record, valid content data corresponding to content data having a validity period including the predetermined time." The Examiner argues that Goerke discloses these features of

claim 31, stating that the “terms of the grant such as vesting or expiration is equivalent to Applicant’s ‘validity period including the predetermined time.’” Office Action, p. 5. Applicants respectfully disagree.

First, Goerke does not disclose “extracting . . . valid content data from the updated record,” as recited in claim 1. Goerke states that “the regular exchange of employee data . . . is sent each night and serves to update” the data. Goerke, p. 16, para. 4. Therefore, the “regular exchange of data” in Goerke is what updates the data. The “data” in Goerke is not data extracted from an “updated record.” Accordingly, even assuming that Goerke’s updated data corresponds to Applicants’ claimed “updated record,” Goerke does not teach or suggest “extracting . . . valid content data **from** the updated record,” as recited in claim 31 (emphasis added).

Second, Goerke does not disclose “extracting . . . valid content data . . . having a validity period including the predetermined time,” as recited in claim 1. Goerke states that “a company always sends only data of such persons who are eligible and/or have elected to participate.” Goerke, p. 16, para. 3. Therefore, Goerke extracts data based on eligibility and election to participate. Goerke, however, does not teach or suggest “extracting . . . valid content data . . . [based on] a **validity period** including the predetermined time,” as recited in claim 31 (emphasis added).

On page 5 of the Office Action, the Examiner acknowledges that Goerke is deficient with respect to other elements of claim 31, including “producing an internal document that includes the valid content data extracted from the updated record” and “producing a file based on the internal document that includes the valid content data.”

Applicants note that these elements are additional examples of the manner by which *Goerke* is deficient with respect to claim 31.

In attempt to overcome the deficiencies of *Goerke* and establish a basis for the Section 103 rejection, the Examiner cites *Hanzek* and argues that it would have been obvious to combine the teachings of *Goerke* and *Hanzek* to provide “an effective way to transport data between different systems.” Office Action, pp. 7-8. Applicants traverse. There is no motivation to combine *Goerke* and *Hanzek* in the manner proposed by the Examiner because the cited references relate to disparate systems (i.e., they constitute non-analogous art) and it is not readily apparent how or why one of ordinary skill in the art would make the asserted combination.

The Examiner states that “[i]t would be obvious . . . to have modified Goerke et al. by the teaching of Hanzek . . . [to] provide[] an effective way to transfer data between different systems [that] support different transport communication mechanisms.” Office Action, pp. 5-6. However, *Goerke*’s system already includes the “definition of elements required to exchange data.” *Goerke*, Abstract. Furthermore, *Goerke* describes its system as being “flexible enough to exchange . . . data in a manner suitable for use by all the involved parties.” *Goerke*, p. 3. Therefore, there would not have been any motivation to add the features of *Hanzek* since all parties in the *Goerke* system are compatible to exchange data. Accordingly, there is no motivation to combine these features of *Hanzek* with *Goerke* in the manner suggested by the Examiner.

Moreover, even if one assumes that *Goerke* and *Hanzek* are properly combinable as the Examiner asserts, *Hanzek* does not overcome all of the deficiencies

of *Goerke*, including with respect to the claimed features of “extracting . . . valid content data from [an] updated record” and, more specifically, “extracting . . . valid content data . . . [based on] a **validity period** including the predetermined time.” Applicants also disagree with the Examiner’s assertion that *Hanzek* teaches or suggests “producing an internal document . . . ” or “producing a file based on the internal document. . . ” as recited in claim 31. Accordingly, *Goerke* and *Hanzek*, whether taken alone or in any proper combination, fail to teach or suggest each and every element of claim 31. Accordingly, a *prima facie* case of obviousness has not been established and the rejection should be withdrawn.

Independent claims 38, 45, and 52, although different in scope from claim 31, recite features similar to those of claim 31. Therefore, claims 38, 45, and 52 are also allowable over *Goerke* and *Hanzek* for at least reasons similar to those given above with respect to claim 31. In addition, dependent claims 32-27, 39-44, 46-51, 53, and 54 are allowable over *Goerke* and *Hanzek* at least by virtue of their dependence from allowable base claims 31, 38, 45, and 52. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 31-54 under 35 U.S.C. § 103(a).

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of all the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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